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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,481	07/29/2003	Gerard M. Cuomo	2946	7459

7590 10/26/2004

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EXAMINER

KING, ANITA M

ART UNIT PAPER NUMBER

3632

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,481

Applicant(s)

CUOMO, GERARD M. 

Examiner

Anita M. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is the second office action for application number 10/629,481, Surgical Microscope Apparatus, filed on July 29, 2003.

Drawings

In order to avoid abandonment, the drawing informalities noted in the paper mailed on March 25, 2004, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

Claim Rejections - 35 USC § 112

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has ambiguous claim terminology where it is unclear whether latter recitations of originally cited terminology are intended to refer to the originally cited terms. It is unclear if "a dental chair," bridging lines 4 and 5 of the claim is intended to refer to the original recitation of the term "a dental chair," bridging lines 1 and 2 of the claim. Applicant is suggested to change the later recitation to either --the dental chair-- or --said dental chair--.

Claim 2 recites the limitation "said vertical support" bridging lines 2 and 3 and line 4 and "said microscope support" in line 3. There is insufficient antecedent basis for these limitations in the claim. The original recitations are cited as "a substantially

vertical microscope support arm," in line 4 and "a horizontally movable microscope positioning arm" in line 6 of the claim 1.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,170,336 to Malis. Malis discloses a surgical microscope system (10) capable of operating a vertical focus surgical microscope over a dental chair, comprising: a substantially vertical microscope support arm (14) capable of being fitted on a dental chair; a horizontally movable microscope positioning arm (18) having a plurality of hinged links, connected to the vertical support arm with a clamp (44) allowing vertical orientation along the length of the vertical support arm; and a microscope coupler (30) for connecting the microscope to the positioning arm, whereby the microscope system is supported for vertical motion and location the vertical support arm and the positioning arm.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,571,038 to Jako in view of Malis. Jako discloses a surgical microscope

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system for operating a surgical microscope over a dental chair of the type having a hinge for rotating the patient position near the patient's hips, comprising: a substantially vertical microscope support arm (see Fig. 1) adapted for fitment on a dental chair adapted for vertical motion in concert with chair vertical motion (Col. 3, line 16ff); a horizontally movable microscope positioning arm (14) having a plurality of hinged links, connected to the vertical support arm; and a microscope coupler (12) for connecting the microscope to the positioning arm; whereby the microscope system is supported for vertical motion and location the support arm; and whereby motion of a portion of the chair is used to focus the microscope.

Jako inherently discloses a method of using a surgical microscope with a chair having a movable chair bottom and having a rotatable chair back comprising the steps of: mounting a microscope on a substantially vertical pole connected to a dental chair bottom; moving the chair bottom to position the microscope at a location comfortable for the microscope user; rotating the seat back about a pivot point bringing the subject into approximate focus of the microscope; and manipulating the variable focus of the microscope to refine the focus to suit the user.

Jako discloses the claimed invention except for the limitation of a clamp. Malis teaches a clamp (44) used to attach a vertical support arm (14) to a positioning arm (18) and wherein the clamp allows vertical orientation along the length of the vertical support arm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the system in Jako to have included the clamp as

taught by Malis for the purpose of providing a more adjustable system to accommodate the user.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malis in view of U.S. Patent 2,697,776 to Wale. Malis further discloses a terminal link formed by elements 28 and 30b, with a repositionable axis of rotation orthogonal to the vertical support proximate the microscope. Malis discloses the claimed invention except for the limitation of the terminal link having several discreet pre-selected angles of inclination. Wale teaches a system having a terminal link (10) with a repositionable axis of rotation, and having an opening (@12) for receiving a cylindrical member (14) and a pivot pin (22) for insertion into an aperture in a tube (26) whereby a support (40) may be inclined at any of several discreet pre-selected angles with respect to another support (C). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the terminal link in Malis to have included the link as taught by Wale for the purpose of providing an alternative, mechanically equivalent means for adjusting an object such as a microscope in a variety of positions in relation to a support system.

Response to Arguments

Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 122,370 to Doolittle

U.S. Patent 2,508,974 to Soditch et al.

U.S. Patent 5,123,619 to Tomlinson et al.

Doolittle discloses an adjustable umbrella holder having adjustable pre-selected angular positions. Soditch et al. disclose a lantern holder having a coupler allowing inclination of pre-selected angular positions. Tomlinson et al. disclose an adjustable cable clamp having variable pre-selected angular positions.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anita M. King
Primary Examiner
Art Unit 3632

October 20, 2004